Application No. 09/376,794
Applicants: Rainer Kropke et al.
Amendment in Response to Office Action dated March 5, 2004

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

Claims 18-27 are pending. New claim 27 has been added. It is supported by the instant specification at page 9, lines 11-13.

Rejections under 35 U.S.C. 103

The Examiner rejected claims 18-26 under 35 U.S.C. 103(a) as being obvious in view of EP 0 771 566 or Magdassi et al. (U.S. Patent No. 5,518,736) or FR 2,667,072 in view of Jordan (U.S. Patent No. 5,885,617).

The Examiner also rejected the claims as being obvious over EP 0 771 566 or Magdassi et al. or FR 2,667,072 in view of JP 63211208 and JP 03074316, further in view of Jordan.

The Examiner found each one of EP 0 771 566, Magdassi, and FR 2,667,072 to teach an emulsion containing chitosan and a phospholipids, but concedes that none of the references teach phospholipids to reduce tackiness. In addition, the Examiner concedes EP 0 771 566 and Magdassi does not explicitly state the molecular weight and the degree of deacylation. According to the Examiner, the JP references teach a phospholipid containing cosmetic

compositions are non-sticky. The Examiner cited Jordan to show lecithin to be a known anti-tack agent. The Examiner ultimately found it would have been obvious to a person skilled in the art that lecithin would reduce the tackiness of the composition. The Examiner also found in view of the EP reference, it would have been obvious to use the instantly claimed chitosans because "these polysaccharides stabilize the emulsions and that chitosans with different molecular weights and degree of deacylation are readily available on the market".

In response, Applicants believe the Examiner has not made out a *prima facie* case for obviousness. Regarding the allegation of obviousness of using chitosan, Applicants submit the Examiner cannot rely on generalized statements without providing reasoning upon which the finding is based. The Examiner relies on page 2 of the EP references which states:

> Presently, there are several types of chitosan available in the market. They differ in their molecular weight, deacetilation degree and the type of salt or acid form.

The Examiner's statement indicating chitosans are "readily available in the market" is believed to be a generalized statement, which cannot be relied upon without providing reasoning upon which the finding is based. The mere fact that "several types of chitosan" are available is not sufficient to support his conclusion. As the Federal Circuit noted in *In re Sang-Su Lee,* "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.' " The Board's findings must extend to all material facts and must be documented on the record.." *See In re Sang-Su Lee,* 61 U.S.P.Q.2d

1430 (Fed. Cir. 2002). The Examiner has repeated this position numerous times in previous Office Actions. However, there is no documentation or record supporting the Examiner's allegation.

Further on this point, to establish a *prima facie* case of obviousness the Examiner must cite prior art references teaching all the claim limitations or take official notice of these claim limitations. Applicants point out that official notice "unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." *MPEP* §2144.03. Moreover, circumstances for relying on Official Notice should be "rare when an application is under final rejection". *MPEP* §2144.03. If Official Notice is being taken, the Applicant requests that the Examiner provide a reference supporting this position. The facts at issue in the instant case do not fall in this category. They are not facts "capable of instant and unquestionable demonstration as being well-known" in which a person skilled in the art would have used chitosan having the instantly claimed average molecular weight and degree of deacetylation. Rather, the Examiner has simply concluded these facts and as a result, alleged the claims are obvious, and as such the Examiner's rationale falls into the category of the "obvious to try" standard which is presumptively improper. *See MPEP* §2145 ("Obvious to Try Rationale"). The Examiner's assertion that a person skilled in the art would have found it "obvious...to utilize" without the citation of documentary evidence and support, is only a statement that it would have been "obvious to try" chitosan having the instantly claimed average molecular weight and degree of deacetylation. As the Federal Circuit noted in *In re*

Grabiak, generalization of this type should be avoided. *See In re Grabiak,* 226 USPQ 870 (Fed. Cir. 1985) ("[G]eneralization should be avoided insofar as specific chemical structures are alleged to be *prima facie* obvious one from the other").

Even if a *prima facie* case for obviousness has been made, which Applicants do not concede, there is still no motivation or suggestion in the references that would have led a person skilled in the to obtain the instantly claimed invention, wherein chitosan has "an average molecular weight of from 100,000 to 1,000,000 and a degree of deacetylation of > 55 to 99%". Amongst the primary references cited by the Examiner, only FR 2667 072 has any indication whatsoever, which states that chitosan preferably has a molecular mass above 5,000, but there is no indication as to the degree of deacetylation of chitosan. The Examiner already concedes Magdassi and EP 0 771 566 contains no explicit teaching of the molecular weight and the degree of deacetylation for chitosan. Therefore, in view of each of the teachings of Magdassi, EP 0 771 566, and FR 2667 072, a person skilled in the art would have been led to believe that chitosans which "differ in their molecular weight, deacetilation degree and the type of salt or acid form" would have a molecular mass of greater than 2000 but no indication as to the degree of deacetylation. Should the Examiner allege that the value of "greater than 2000" encompasses the instantly claimed values of from 100,000 to 1,000,000, Applicants refer the Examiner to MPEP §2144.08 wherein the Examiner should consider the size of the "prior art genus, bearing in mind that size alone cannot support an obviousness rejection". Moreover, there is "no absolute correlation between the size of the prior art genus and a conclusion of obviousness", and ultimately "some motivation to select the claimed species or subgenus must be taught by

the prior art." MPEP §2144.08 ("Consider the Size of the Genus"). Applicants submit there is nothing that would have led a person skilled in the art to a molecular weight of 100,000 where the only hint of suggestion is a value of "more than 2000" and EP 0 771 566 only refers to the chitosan in general terms. Clearly, in the absence of a suggestion thereof, there is nothing to indicate that a person skilled in the art would multiply the value set forth in FR 2667 072 by a factor of 50 to obtain the instantly claimed molecular weight of the chitosan, notwithstanding the fact that there is no indication in any of the references of a degree of deacetylation of the chitosan. Accordingly, the claims are not rendered obvious by the references.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw these rejections. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Conclusion

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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Early and favorable action is earnestly solicited.

Respectfully submitted,

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